

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

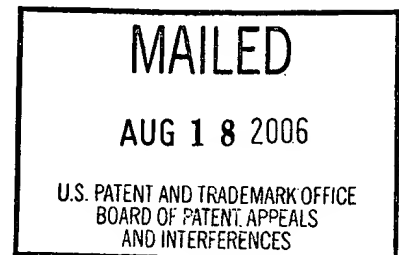
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABIGAIL J. SELLEN, BARRY A.T. BROWN
and ANDREW D. MORGAN

Appeal No. 2006-1766
Application No. 09/773,090

ON BRIEF



Before KRASS, BLANKENSHIP, and HOMERE, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-18.

The invention is directed to a text processing system. In particular, an auxiliary screen functions as an independent word processor, wherein a user is enabled to edit text in a manner similar to that employed when using paper.

Representative independent claim 1 is reproduced as follows:

1. Text processing apparatus comprising:

a first text editing unit having a screen upon which text may be displayed, and a first manual actuator by means of which a user is able to interact with text displayed on the first screen;

a second text editing unit having a second screen upon which text may be displayed, and a second manual actuator by means of which a user is able to interact with text displayed on the second screen; wherein

the first and second actuators are independently operable, and enable interaction with text displayed on respective screens independently of each other; and

the first and second text editing units are connected to each other to enable text to be imported from one unit directly to another unit, thereby to enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit.

The examiner relies on the following references:

Kashiwagi et al. (Kashiwagi)	6,396,598	May. 28, 2002 (filed Aug. 26, 1998)
Karidis et al. (Karidis)	6,727,894	Apr. 27, 2004 (filed Jun. 09, 2000)
Robotham et al. (Robotham)	6,704,024	Mar. 09, 2004 (effective filing date Aug. 07, 2000)

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Claims 1-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Karidis and Kashiwagi with regard to claims 1-8 and 10-18, adding Robotham with regard to claim 9.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

Taking claim 1 as exemplary, the examiner contends that Karidis discloses the claimed subject matter but for a disclosure of enabling text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit. The examiner turns to Kashiwagi for its teaching of an electronic memo processing apparatus (text editing unit) with a pen (manual actuator) to add a memo (text) overlapped to a document displayed on a computer (another text editing unit), and concludes that it would have been obvious to combine the teachings of the references to include enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit, "and by doing so it would provide user friendly environment which allows a plurality of users to add text from one device to another" (answer-page 6).

Appellants assert that display 108 in Karidis is not a "second screen," as contended by the examiner, but, rather, a display that provides prompts or information to a user. Appellants contend that Karidis does not disclose a user being able to interact with text displayed on display 108. Accordingly, assert appellants, since display 108 only appears to provide prompts or information to a user, and there is no component that allows the user to interact with display 108, Karidis does not disclose a second text editing unit having a "second screen" upon which text may be displayed, and "a second manual actuator" by means of which a user is able "to interact with text displayed on the second screen," as required by the language of claim 1.

Moreover, appellants argue that Kashiwagi does not make up for the admitted deficiency of Karidis in failing to disclose or suggest that text selected from a first document displayed on one unit is to be inserted directly at a predetermined location in a document displayed on the other unit. In particular, appellants contend that in each of the twelve embodiments described in Kashiwagi, a user is allowed to modify a document through the use

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of an input sheet (see the abstract, for example), but no embodiment describes allowing the user to select text that is being displayed (principal brief-page 14).

Appellants argue that neither reference suggests any need or benefit of having a second screen with which a user can interact, and so the combination of these references falls short of making the instant claimed subject matter obvious, within the meaning of 35 U.S.C. § 103.

In response, the examiner altered the rationale a bit by citing the abstract, column 7, lines 19-45, column 9, lines 51-63, and Figures 1, 5, 6, and 10 of Karidis; in particular, recording unit 101 (as the second text editing unit) which includes display 108, a markable surface 150 (second screen) and an inking stylus 152 (second manual actuator), in which the user 154 can use the stylus 152 to write text on the markable surface 150 that is superimposed over the work surface 103 (Figure 10). It is the examiner's position that since claim 1 does not specify any type of screen to be used, Figure 10, items 101, 152 and 946 of Karidis can be fairly interpreted as a form of "screen" displaying editable "text" via a "manual actuator."

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The examiner also contends that Kashiwagi does show two different screens that a user can move or transfer text from/to, in that the tablet of Kashiwagi is considered as one unit or screen that the electronic memo (text) is written on, and the user who writes the electronic memo can edit (add or insert) the electronic memo from the first unit or screen to the document displayed on the display device (second screen). The examiner refers to column 10, line 63-column 11, line 4 of Kashiwagi.

We REVERSE.

We agree with appellants that neither Karidis nor Kashiwagi describes a "second screen," as required by the instant claims.

With regard to display 108 in Figure 5 of Karidis, this display provides prompts for, and/or communicates information to, a user 154 (see column 8, lines 62-63). Thus, the display prompts a user or communicates information to a user, but there is no indication that this display includes any manual actuator that enables a user to interact with any of the text on display 108. The only "interaction" is in the user, for example, being prompted by the display to do something. Moreover, as recognized by the examiner, no text may be imported from/to display 108 to/from a first screen. Thus, no "second screen," as claimed is described in Karidis.

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As for the examiner's reliance on markable surface 150 of Karidis for the "second screen," we agree with appellants that markable surface 150 is not a "second screen," as claimed. The two displays described by Karidis are display 202 and display 108. Markable surface 150 is described as a sheet or pad 160 of paper (see column 7, lines 24-26). Since Karidis distinguishes between a "display" and "paper," it is clear to us that paper markable surface 150 of Karidis cannot be a display screen, as claimed. Text may be displayed on a pad of paper and a pencil or pen may be a "manual actuator" for interacting with text on that paper, but such an analogy breaks down when the claimed requirement of enabling text to be imported from one unit directly into another unit is taken into account. Now one might say that Kashiwagi teaches this limitation. However, even if Kashiwagi discloses everything the examiner alleges, it would not seem apparent to the skilled artisan, without some suggestion in the references, why a pad of paper should be replaced by a display screen which enables text to be imported from one unit to another.

With regard to Kashiwagi and the examiner's apparent reliance on the tablet 66 of Kashiwagi as one unit or screen that the electronic memo (text) is written on, we find no indication in Kashiwagi that this tablet 66 is a unit for displaying a document. Rather, the tablet appears to be something a memo is written on, as an input device (see column 11, line 24 of Kashiwagi), not a "second screen," as claimed.

We agree with appellants' observation, at pages 4-5 of the reply brief:

Both of the Karidis...and Kashiwagi...patents are directed toward apparatuses that enable a user to provide input in written form, for insertion into a document. In the Karidis...patent, the user provides input via markable surface 150. In the Kashiwagi...patent, the user provides input via tablet 66. Both of the Karidis...and Kashiwagi...patents fully provide for the receipt and processing of input from the user. Neither of the Karidis...patent nor the Kashiwagi...patent have any apparent need for another screen upon which text may be displayed, with which the user can interact. Thus, neither of the Karidis...patent nor the Kashiwagi...patent provides any motive for a second screen upon which text may be displayed, and a second manual actuator by means of which a user is able to interact with text displayed on the second screen, as recited in claim 1 (emphasis in the original).

Thus, appellants conclude that there would have been no motive for the cited combination, and we agree.

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Accordingly, the rejection of claims 1-8 and 10-18 under 35 U.S.C. § 103 is reversed.

Since Robotham does not provide for the deficiencies of the two primary references, Robotham being relied on for a specific type of connection, we also will not sustain the rejection of claim 9 under 35 U.S.C. § 103.

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The examiner's decision rejecting claims 1-18 under 35
U.S.C. § 103 is reversed.

REVERSED



ERROL A. KRASS)
Administrative Patent Judge)



HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

BOARD OF PATENT

APPEALS AND

INTERFERENCES



JEAN R. HOMERE)
Administrative Patent Judge)

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